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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/415,632	10/12/1999	Suzanne P. Crane	10655.7700	5093

7590

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EXAMINER

POINVIL, FRANTZY

ART UNIT	PAPER NUMBER
3628	

DATE MAILED: 09/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/415,632	Applicant(s) CRANE ET AL.	
	Examiner Frantzy Poinvil	Art Unit 3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 6/29/2006 have been fully considered but they are not persuasive.

Applicant's representative argues that the Examiner erroneously attempts to equate an incentive award system with an investment broker system.

In response, the Examiner respectfully disagrees with the applicant's assertion. The Examiner indicated that "Burton et al teach an investment broker system such as a future incentive award system for providing funds to a cardholder based on the amount charged in that card during a given period". The system of Burton et al operates in a manner similar to an investment broker system since there includes a system which manages cardholders' accounts, reports and incentive data. Furthermore, in the system of Burton et al, a specific or selected amount of funds is used or allocated for a special use planned by the cardholder or participant. See page 6, lines 5-12 of Burton et al. Burton et al further teach providing a combined report to a cardholder or participant. See column 5, lines 45-54.

Applicant's representative then argues that Burton et al do not need to remit a payment to pay for the purchases. In response, the Examiner disagrees. Burton et al do teach converting award points to monetary values on the participant credit instrument or credit card. However, not all the amounts owed on a credit instrument

(from incurred charges on purchases made by the cardholder) are paid from award points. If this is the case, the system of Burton et al would not survive economically. Such would be an economic or financial chaos or failure. The award points would not be sufficient to pay or cover a large bill or amount incurred on the credit instrument. Thus, applicant's argument is not convincing because the cardholder must also pay whenever the converted award points are insufficient to cover incurred charges or purchases made by the cardholder.

Applicant's representative then argues that "Not only does the Burton participant not need a payment remittance, but the Burton system does not include an extra remittance which is distributed to another system".

In response, the Examiner disagrees because in the system a cardholder must make payments to incurred charges or purchased goods/items or services. In addition, it is noticed that an extra remittance being distributed to another system is taught by Cohen et al.

Applicant's representative then argues that Cohen et al discourage the use of a charge cards. In response, Cohen et al have not been applied to note teachings of the use of a charge card. The type of payment that Cohen et al use to accept payments from purchasers is irrelevant. In purchasing goods or services, Cohen et al teach that purchasers submit payments to a purchasing center, which sends instructions to pay the related vendor from an escrow agent. It would have been obvious to one of ordinary skill in the art that the funds can be any acceptable payments such as cash, credit or debit which were well used at the time of the applicant's invention in order to encourage

various types of payments therein. Nonetheless, Cohen et al have been applied to show teachings of allocating or distributing funds to at least one investment product. See column 3, lines 1-26 of Cohen et al.

Applicant's representative then states that Cohen et al teach away from the claimed invention.

In response, the Examiner disagrees. Cohen et al teach a system in which a customer purchases a good or service and provides payment to the seller of the goods or services. The system then provides an incentive by providing a rebate factor, which allocates funds to a benefit guarantor such as an insurance company. See the abstract of Cohen et al. A combined report is generated for the purchaser. See column 2, lines 1-44 and figure 5 of Cohen et al.

Applicant's arguments against the references individually, as noted is improper as one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over (Burton et al EPA 0 308 224) in view of Cohen et al. (US Patent No. 4,750,119).

As per claims 1 and 6, Burton discloses a method and system for providing an incentive award to purchase cardholder. (See the abstract of Burton). The system and method include:

a charge card billing system configured to capture financial event information wherein the billing system comprises a card account database configured to include user accounts, a billing information database, a financial events database, a remittance database configured to include information about user remittances, wherein the combined remittance includes a portion of funds to satisfy debts related to the financial events.

Burton also discloses providing periodic statements related to previously established financial events.

Burton et al also teach an investment broker system such as a future incentive award system for providing funds to a cardholder based on the amount charged in that card during a given period. The broker system is in communication with the billing system wherein the broker system comprises:

an instruction arrangement database configured to include user investment instruction information;

an account database configured to include multiple investment products;

an payment hierarchy system for establishing rules for distributing funds to the at least one product.

Applicant is directed at page 5, line 44 to page 6, line 50 of Burton et al.

Burton et al do not explicitly teach a remittance database configured to include information about user combined remittances wherein the combined remittances include a portion of funds to satisfy debts related to previously established financial events disclosed in a periodic statement and a portion of funds for investment.

Cohen et al teach a system and method in which a central system manages billing data and investment data based on an amount spent by a customer. See the abstract. In so doing, Cohen et al teach a remittance database configured to include information about user combined remittances wherein the combined remittances include a portion of funds to satisfy debts related to previously established financial events disclosed in a periodic statement and a portion of funds for investment. See columns 4, 7 and 8 of Cohen et al.

Cohen et al further teach a payment hierarchy system for establishing rules for distributing the combined remittances to the previously established financial events and to an investment brokerage system (see column 4, lines 34-63 and column 7, lines 20-44 of Cohen et al).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Cohen et al into that of Burton et al in order to provide a cardholder a more safer and reliable return in an investment strategy thereby providing a better and more attractive incentive system.

As per claims 2 and 7, Cohen et al disclose the investment products include at least one of a fixed annuity, variable annuity, CD, insurance, certificate, equity and mutual fund. See column 3, lines 1-37.

As per claims 3 and 8, Cohen et al teach the billing system is configured to avoid a collection process upon remittance of sufficient financial event funds and insufficient investment funds. See column 2, lines 27-44 of Cohen et al.

As per claim 4, Cohen et al. teach that the investment products are pre-selected by cardholders. Note column 4, lines 10-24.

As per claims 5 and 10, Burton discloses the billing system and the investment broker system are configured to be accessed via at least one of a telecommunications linkage, facsimile, Internet and a point of interaction device. See column 31, lines 39-50 and column 32, lines 36-63 of Burton et al.

As per claim 9, Cohen et al disclose selecting the investment products prior to the remitting step.

3. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over (Burton et al EPA 0 308 224) and Cohen et al. (US Patent No. 4,750,119) in further view of Sandberg-Diment (US Patent No. 5,826,245).

The teachings of Burton et al and Cohen et al are discussed above. Burton teaches a cardholder using a purchasing card having an account number for purchasing goods/services from a merchant and later receives a periodic statement, which includes the purchase amount. See column 2, lines 52-55. Steps of authorizing the account number and purchase amount, providing an approval code associated with the account number and the purchase amount to the

merchant is not explicitly stated in the combination of Burton et al and Cohen et al. The Examiner asserts that these are well known steps taken when using a credit card to make a payment using a financial transaction card. Sandberg-Diment discloses a system and method whereby a cardholder performs a financial transaction using a financial card. An approval code is sent to a merchant who then uses the approval code when requesting a payment for the transaction for the purchase amount. Applicant is directed to column 3, lines 55-67 of Sandberg-Diment.

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Sandberg-Diment into the combined system of Burton et al and Cohen et al in order to discourage fraudulent transactions, thereby providing a more secure system.

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantzy Poinvil whose telephone number is (571) 272-6797. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sam Sough can be reached on (571) 272-6799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Frantzy Poinvil
Primary Examiner
Art Unit 3628

FP
September 18, 2006